

REMARKS

The Patent Examiner has objected to claims 3, 4 and 5 for lack of antecedent for "measuring points" and for a typographical error in spelling "at." Each of these objections has been met by the foregoing Amendments, specifically by providing antecedent support for "measuring points" in claim 1 and correcting the spelling of "at" in claim 5.

On the merits, claims 1, 2 and 5 have been rejected under Section 102 as anticipated by the Rogler patent. Figures 2 and 3 are the sole basis for the rejection of these three claims. However, the limits 26 and 30 in Rogler are movable slidably in and out horizontally in Figures 2 and 3 in order to be "selectively movable to clear or engage an abutment surface of the body" (column 5, lines 61-62). In contrast, the stops in the present invention are movable vertically (longitudinally) to engage the friction surface at two or more measuring points.

In order to clarify the claims and specifically define the measuring points and the stops, claim 1 has been amended in the following respects:

- (1) the "beam" is now "mounted transversely in a cylinder,"
- (2) the "jaws" are now "within the cylinder,"
- (3) the "stops" are now "on each jaw,"
- (4) each "stop" is now "movable longitudinally" between the limits, and
- (5) the measurement of distance is at "measuring points corresponding" to the limit positions.

Claim 5 also specifies longitudinal movement of the stops, as opposed to the transverse movement of pins in Rogler.

As amended, the claims clearly distinguish over the Rogler patent. Applicant was well aware of the Rogler patent because Applicant is the owner of a company that sells calipers in competition with the assignee of the Rogler patent, Central Tools, Inc. Previously, Applicant's company imported calipers having the slidable pins described and claimed in the Rogler patent without knowledge of the patent. Central Tools sued Applicant's company, and Applicant immediately ceased importing calipers with the slidable pins.

After the case was settled, undersigned counsel reviewed the prosecution history of the Rogler patent. The original patent claims were in "means plus function" format, without any structure defining "adjustable depth control means." The claims were rejected on the patent to Mitchell 3,827,153 that shows structure serving the function of adjustable depth control means.

Central Tools then amended the claims to require that the structure be "selectively movable to clear or engage an abutment surface."

This is a classic case of prosecution history estoppel. The Rogler claims were amended in order to overcome prior art and the means plus function format was surrendered in Rogler. The structure here claimed is entirely different from Rogler, and is not obvious or anticipated by Rogler. Nothing in Rogler suggests the use of longitudinal movement of stops to allow measurement of diameter in a plurality of points in a cylinder.

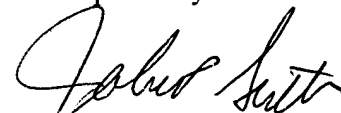
As to claims 3 and 4, they have been rejected as obvious in view of Rogler. These claims are dependent on claim 1, and the amendments to claim 1 to specify longitudinal movement of the stops, rather than transverse movement of pins in Rogler,

serve to distinguish claims 3 and 4 as well as claim 1. It is not a matter of routine skill in the art to move the stops longitudinally within the cylinder. It is a difference in kind, and not optimizing the range of movement.

The patents of record that are not relied on do not show the longitudinally movable stops of the present invention. It is submitted that the claims are now in condition for allowance. Favorable action is requested.

Dated: September 20, 2004

Respectfully submitted,



JOHN P. SUTTON (Reg. No. 22,430)

2421 Pierce Street

San Francisco, CA 94115-1131

Telephone: (415) 929-7408

Facsimile: (415) 922-2885

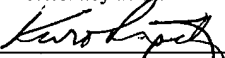
Attorney for Applicant

Eva J. Tsai

Certificate of Mailing [37 CFR §1.8(a)(1)(i)(A)]

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Dated: September 20, 2004 JOHN P. SUTTON
Attorney at Law

By 
Kurt Lipschutz